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EXAMINER

NGUYEN, PHILLIP H

ART UNIT	PAPER NUMBER
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2191

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/714,018

Applicant(s)

PIZZOLI ET AL.

Examiner

Phillip H. Nguyen

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 3/28/2007. Claims 1-20 remain pending and have been considered below.

Response to Arguments

2. Applicant's arguments with respect to claims 2, 11 and 20 have been considered but are moot in view of the new ground(s) of rejection.

Applicant asserts on page 7 of the amendment that software code alone qualifies as an invention eligible for patenting under 35 U.S.C. 101.

Examiner respectfully disagrees with the allegation as argued. Claim 1 recites a system but all the components that make up this system are software. Software is non-statutory subject matter because it is lacking storage on a medium or storage device, which enables any underlying functionality to occur. See MPEP 2106.01 [R-5].

Applicant is suggested to add a processor and a storage device that stores these cited software components to overcome the rejection.

Applicant asserts on page 8 of the amendment that Halviatti fails to teach script translation means for intercepting a call from the automation script to a function simulating a user action on the application without intercepting the application at run-time.

Examiner respectfully disagrees with the allegation as argued. Halviatti teaches "the message Engine may trap each CreateWindow API call for determine each screen object which is about to be created" col. 24, lines 33-35, but does not teach intercepting

the application at run-time. Examiner in his previous action gave detail explanation of claimed limitation and pointed out locations in the cited prior art that are relevant.

Examiner notices that Applicant has amended claims 1, 10 and 19. However, Examiner could not find any written description or support for this newly added limitation in the specification. Therefore, Examiner interprets it as a new matter. Applicant is suggested to point out the location of the newly added limitation in the specification that currently claimed invention supports this newly added limitation.

Applicant further asserts on pages 8-9 of the amendment that Halviatti fails to teach "selective text locator means coupled to the message translation means for selectively supplying appropriately translated text to the automation script's run time execution depending on the function call in a case that a same text string is translated differently based on context.

Examiner respectfully disagrees with the allegation as argued. Halviatti discloses "the Script Engine identifies the event by mapping the message into its set of known reserved words according to the instructions of the script...upon completion of this step, the method has successfully dispatched the meta-message with appropriate actions being effected in response to that message" col. 17, lines 44-51. Halviatti further discloses "ATM above can represent different language versions of the Confirmation dialog without any modification" col. 30, lines 13-15.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification. See MPEP 2111 [R-1] Interpretation of Claims-Broadest Reasonable Interpretation. During patent examination, the pending

claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during the prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541, 550-51 (CCPA 1969).

Specification

3. The amendment filed 3/28/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "without intercepting the application at run-time".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-9 and 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- Regarding claim 1-9 recite a system but it appears reasonable to interpret this system by one of the ordinary skill in the art as software per se. Application's specification provides no explicitly and deliberately definition of the components

("automation script" and "script translation") that make up the system other than they could be software components, which are directed to functional descriptive material, per se, and are therefore, non-statutory.

- Regarding claim 19-20 recite a computer readable medium, which may be including "data carrier" (see paragraph [0079]). The specification provides intrinsic evidence that the computer readable medium is intended to cover signals, such are currently not believed to enable the computer readable medium to act as a computer hardware component and realize its functionality absent being claimed in combination with the necessary hardware to receive and convert the signals to computer program code.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 10 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added material ("...without intercepting the application at run-time") is considered as new matter because Examiner could not find any written description in the specification to support this newly added material.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 8-15, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Halviatti et al (Patent Number: 5,475,843).

As per claims 1, 10 and 19:

Halviatti discloses:

- automation script means for receiving an automation script for automating use of the user interface in an application ("**sends appropriate script scenes to the Script Engine**" col. 10, lines 36-37; **also see for example, FIG. 6, and texts which further expand their features** col. 21, lines 35-46); and
- script translation means for intercepting a call from the automation script to a function simulating a user action on the application without intercepting the application at run-time ("**Message Engine may trap each CreateWindow API call for determining each screen object which is about to be created**" col. 24, lines 33-35), retrieving a translated text string associated with the function call ("**retrieved by a call to GetMessage(...)**" col. 7, lines 55-62), and calling the function simulating the user action with the translated text string ("**class methods are provided for simulating user events. For instance, the Click(),**

DbiClick()..." col. 33, lines 25-30; "user interaction simulation, and Resource tracking" col. 34, line 16; "Each GEM can simulate any possible operation that a user would perform on any given element..." col. 35, lines 38-44).

As per claims 2, 11 and 20:

Halviatti discloses:

- message translation means for supplying translated text for the automation script's run time execution ("**TranslateMessage()**" col. 7, line 64; "**ATUs translate low-level messages into high-level messages**" col. 22, lines 39-40); and
- selective text locator means ("**GetMessage()**" – **a message is retrieved by a call to GetMessage()**" col. 7, line 61; **retrieving a message/text is the same as locating a message/text**) coupled to the message translation means for selectively supplying appropriate text to the automation script's run time execution depending on the function call ("**the retrieved message may be translated by a call to TranslateMessage**" col. 7, lines 63-64).

As per claims 3 and 12:

Halviatti discloses:

- wherein the selective text locator means is arranged to selectively supply appropriate text to the automation script's run time execution depending on a resource ID of the function call ("**an unique id is constructed for this top level**

**menu...the resource database is search for the record under this id...the
tope level menu string from the menu handle is retrieved...a preferred
name is also retrieved...” col. 37, lines 4-10).**

As per claims 4 and 13:

Halviatti discloses:

- a library (**“GEM Library”** col. 31, line 21, a **collection of GEMs**) including a function having the same signature as the function call and which is arranged to retrieve the translated text string before the function call (**“a GEM encapsulates the behavior of irreducible user interface elements such as push buttons, checkboxes, listboxes, menu items...when GEM is instantiated, it takes two parameters...the GEM can be instructed to run a self test method by simple comparing its expected attributes against its actual attributes (retrieved from the actual element on the screen which the GEM represents)”** col. 31, line 60 – col. 32, lines 1-60); and
- one of a file (**“a GEM”** col. 31, line 43) referencing the library (**“when a GEM instantiated, it takes two parameters: a reference to its parent and...”** col. 31, lines 52-44; **a GEM is also considered as a file or a program, it references to its parent, a library**), the automation script being arranged to reference the file and the library (**“Upon invocation of a test script, the Test Runtime Library is loaded, the resource database is opened and initialized the GEM library classes are loaded...”** col. 41, lines 15-20; which means,

when the a test script is being tested, the GEM library classes gets called), and the library including the retrieval function (“self test method is comparing its expected attributes against its actual attributes (retrieved from the actual element on the screen which the GEM represents)” col. 31, lines 51-55) and the function call (“a GEM ... a reference to its parent” col. 31, lines 43-44, a call to its parent) , the library being arranged to be called by the automation script (“Upon invocation of a test script, the Test Runtime Library is loaded, the resource database is opened and initialized the GEM library classes are loaded...” col. 41, lines 15-20; which means, when the a test script is being tested, the GEM library classes get called).

As per claims 5 and 14:

Halviatti discloses:

- wherein the file referencing the library comprises an include file (“**Appendix E: Window Proxy**” col. 49).

As per claims 6 and 15:

Halviatti discloses:

- wherein the library including the retrieved function and the function call has the same name as a library containing the function called by the automation script (“**GEM Library**” col. 31, line 21; **GEM Library including retrieved function and**

function call disclosed above and is called by automation script upon invocation of a test script).

As per claims 8 and 17:

Halviatti discloses:

- wherein the automation script is in the English language and the application is arranged to use a non-English language ("**a lingua franca or common language for all events**" col. 9, lines 20-22).

As per claims 9 and 18:

Halviatti discloses:

- wherein the user interface comprises a graphical user interface (**FIG. 1, and text, which further expand their features**, col. 5, line 51).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halviatti et al. (Patent Number: 5,475,843), in view of Laane (Patent No.: US 6,978,445 B2).

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As per claims 7 and 16:

Halviatti discloses:

- wherein the automation script comprises a Java™ script.

However Laane discloses an analogous system including Java™ script (“**Javascript**” col. 5, line 47).

Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Halviatti’s system to include Java™ script. One of the skilled in the art would have been motivated to modify Halviatti’s system because the user select the value from the dropdown, hits Go, and the choice is made. By using Java™ script, a programmer can have the list notify him/her when a change is made, and a programmer can essentially hit that Go button for the user. This saves the use all the hassle of clicking on a button.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip H. Nguyen whose telephone number is (571) 270-1070. The examiner can normally be reached on Monday - Thursday 10:00 AM - 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PN
5/30/2007


WEI ZHEN
SUPERVISORY PATENT EXAMINER